

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Volker Deichmann
Serial No.: 10/019,329
Date Filed: May 9, 2002
Group Art Unit: 2618
Confirmation No.: 6261
Examiner: Tran, Tuan A.
Title: **MOBILE PHONE WITH EXPANDED
TELEPHONE DIRECTORY**

MAIL STOP – AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL REQUEST AND ARGUMENTS

The following Pre-Appeal Brief Request for Review (“Request”) is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (“OG Notice”). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

REMARKS

Applicant contends that the rejections of Claims 9-16 on prior art grounds contain clear legal and factual deficiencies, as described below. As of the time of the Final Office Action dated September 15, 2008, Claims 9-16 stood rejected under 35 U.S.C. § 103(a) as being unpatentable over PCT Publication No. 98/30053 filed by Thomas J. Holmstrom et al. (“*Holmstrom*”) in view of U.S. Patent No. 6,009,338 issued to Yuji Iwata et al. (“*Iwata*”).

Applicant contends that the rejections of Claims 9-16 are not proper for at least the reasons described in Applicant’s Response dated December 12, 2008 at Pages 4-5 (“Applicant’s Response”). In short, Applicant contend that, contrary to the Examiner’s assertions, the cited references do not teach, either alone or in combination, each and every element of the recited claims.¹

For example, independent Claim 9 recites, in part:

at least one database stored in the nonvolatile memory and, *each of the at least one database being respectively assigned to precisely one of the at least one electronic telephone directory.* (emphasis added).

As noted in Applicants’ Response, the Examiner conceded that *Holstrom* fails to teach or suggest the above-recited element. (Final Office Action, Page 2). Despite Examiner’s assertions to the contrary, Applicant also submits that *Iwata* also fails to teach or suggest the above-recited element of Claim 9. The Examiner attempts to show that *Iwata* teaches the above-recited element by stating that “*each entry of a telephone directory (e.g., MATSUURA JIRO) being assigned to precisely a corresponding expansion telephone directory entry having a data filed of variable size with respect to a number of additional attributes assigned to the telephone entry.*” *Id.* (emphasis added). Thus, in maintaining the rejection, the Examiner has equated an entry in a telephone directory to a database. This attempted equivalence is improper for numerous reasons.

¹ It is noted in the OG Notice at <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm> that “Applicants are encouraged to refer to arguments already of record rather than repeating them in the request.” Accordingly, Applicants refer here to, and summarize, the previous arguments rather than reciting them explicitly.

First, the Examiner's construction of Claim 9 is contrary to the actual wording of the claim itself. In addition to the above-recited element, Claim 9 also recites "wherein each entry of a telephone directory is assigned to a corresponding database entry . . ." Thus, Claim 9 has elements that recite each of "at least one database," "at least one electronic telephone directory," and "each entry of a telephone directory." Accordingly, Claim 9 explicitly contemplates that a "database" and an "entry of a telephone directory" are not equivalent. It is a bedrock principle of patent law that when an applicant uses two different terms in a single claim, the two terms are presumed to have different meaning. *See, e.g., Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1373 (Fed. Cir. 2004) ("the use of [two] terms in close proximity in the same claim gives rise to an inference that a different meaning should be assigned to each"); *see also Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 391 F.3d 1111, 1119 (Fed. Cir. 2004) ("when an applicant uses different terms in a claim it is permissible to infer that he intended his choice of different terms to reflect a differentiation in the meaning of those terms"). Consequently, the fact that the Applicant has clearly delineated, within the four corners of single claim, between a "database" on one hand and an "entry of a telephone directory" on the other, it is impermissible for the Examiner to equate a prior art "entry" to a "database," as to do so would read language out of Claim 9, and would be entirely inconsistent with decisions of the Federal Circuit binding upon the Office.

Second, the Examiner's construction of Claim 9 is contrary to the plain meaning of the terms "database" and "entry." Prior to the submission of the Notice of Appeal, Applicant filed an Information Disclosure Statement including a definition of "database" from the *Microsoft Computer Dictionary*, 4th. ed. (1999) and a definition of the word "entry" from the *Merriam-Webster Online Dictionary*. The term "database" means "[a] file of records, each containing fields." *Microsoft Computer Dictionary*, 4th. ed. (1999) (emphasis added). "Entry" means, *inter alia*, "something entered: as (1): a record or notation of an occurrence, transaction, or proceeding (2): a descriptive record (as in a card catalog or an index)." *Merriam-Webster Online Dictionary*, <http://www.merriam-webster.com/dictionary/entry> (retrieved Feb. 15, 2009) (emphasis added). Thus, "database" is properly construed as a collection of records, while "entry" is properly construed as one of such records.

Consequently, the Examiner's attempt to equate "entry" to "database" would be analogous to equating a brick with a building or equating a tree to a forest.

For at least the reasons set forth above and in Applicant's Response, *Iwata*, either alone or in combination with *Holstrom*, fails to teach each and every element of Claim 9, and this, cannot render obvious Claim 9. Because Claims 10-16 depend from Claim 9, Applicant submits that Claims 10-16 are also allowable. Accordingly, Applicant requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and full allowance of Claims 9-16.

CONCLUSION

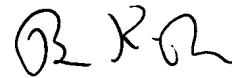
Applicant submits these Arguments in Support of Pre-Appeal Brief Request for Review along with a Notice of Appeal. Applicant authorizes the Commissioner to charge Deposit Account No. 50-2148 in the amount of \$540.00 for the Notice of Appeal.

Applicant respectfully submits a Petition for a Two-Month Extension of Time. The Commissioner is authorized to charge the fee of \$490.00 required to Deposit Account 50-2148 in order to effectuate this filing.

Applicant believes there are no further fees due at this time; however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayments to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2684.

Respectfully submitted,
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Date: Feb, 17, 2009

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